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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/849,445	05/20/2004	Ake Danielsson	024445-483	6364

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DRINKER BIDDLE & REATH (DC)
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WASHINGTON, DC 20005-1209

EXAMINER

HOWELL, DANIEL W

ART UNIT	PAPER NUMBER
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3722

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/22/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/849,445

Applicant(s)

DANIELSSON ET AL.

Examiner

Daniel W. Howell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 8-14 and 20-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 8-14, 2-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. It is noted that the present application has a corresponding PCT application which was published as WO 2004/103613 A1, and that the art cited in that PCT has not been provided to the PTO. Applicant is reminded of their duty to disclose related prior art.

2. Claims 1, 3, 8-14, and 20-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1 and 20 both have been amended to set forth a "first material" and a "second material." By setting forth two materials, one skilled in the art would think that these two materials would be different. It is noted that claim 21 states that the first and second materials comprise "a single homogeneous material." With this statement, the scopes of claims 1 and 20 are now highly debatable. If the first and second materials are "a single homogeneous material," then one would think that there really is no "second material." That is, if only "one homogeneous material" is present, then there can't be a "second material" as per claims 1 and 20 (the examiner is aware that claim 21 does not depend from claim 20, but the question involved exists in both claims 1 and 20).

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 8, 9, 14, 20, and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ladendorf (3191463) in view of Bunting et al (4762445). Ladendorf shows a boring tool having front head 20 with a tungsten carbide insert 31 and two guide strips 32 which are brazed to the body. Note also conical opening 42 which leads to a central hole and the

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stepped shape of the cutter. Figure 9 shows a threaded connection between the tool body and a tube. As discussed at lines 19-59 of column 1 (and especially lines 55-59) of Bunting et al, given a cutting insert which is brazed to a tool body, the weakest point of the tool is the braze, such that the braze limits the effective life of the tool. As described at column 3, lines 6-54, Bunting et al shows a tungsten carbide body 21 and a sintered abrasive particles which are sintered to each other, such that the braze is eliminated. In view of this teaching of Bunting et al, it is considered to have been obvious to have sintered the cutting insert and guide strips of Ladendorf with an appropriate body in order to eliminate the braze, such that the resulting tool is more durable.

5. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ladendorf in view of Bunting et al as applied to claim 1 above, and further in view of Green (5486072).

Green shows a situation where both the body 2 and cutting portions 3 are made of tungsten carbide. It is considered to have been obvious to have made the cutter of Ladendorf of a single homogeneous material as shown by Green in order to simplify the manufacturing process.

6. Claims 3 and 10-13 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

7. Applicant's arguments filed 11-27-06 have been fully considered but they are not persuasive. It is noted that the claims have been extensively amended to provide scopes and features which were not set forth in the original claims. A completely new search has been done, and art has been applied as appropriate.

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8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

9. Any inquiry concerning the content of this communication from the examiner should be directed to Daniel Howell, whose telephone number is 571-272-4478. The examiner's office hours are typically about 10 am until 6:30 pm, Monday through Friday. The examiner's supervisor, Monica Carter, may be reached at 571-272-4475.

In order to reduce pendency and avoid potential delays, Group 3720 is encouraging FAXing of responses to Office actions directly into the Group at FAX number to 571-273-8300. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a USPTO deposit account. Please identify Examiner Daniel Howell of Art Unit 3722 at the top of your cover sheet.



Daniel W. Howell
Primary Examiner
Art Unit 3722